

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bednorz et al.

Art Unit: 1105

Serial No.: 08/303,561

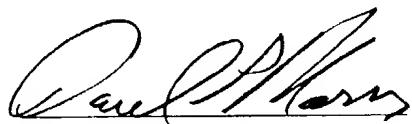
Examiner: D. McGinty

Filed: September 9, 1994

Date: January 3, 1996

For: NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH
TRANSITION TEMPERATURE, AND METHODS FOR THEIR
USE AND PREPARATION

I hereby certify that this paper is being facsimile transmitted under Rule 37
CFR §1.161(d) to the U.S. Patent and Trademark Office on the date shown
above.



Daniel P. Morris

Reg. No. 32.053

SUPPLEMENTARY RESPONSE

The Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Office Action dated March 29, 1995, please consider the following:

REMARKS

These remarks are in addition to those of the previously submitted response.

As further support for applicants' position that the claims under examination are supported by applicants' specification the attached affidavit of Dr. Chang C. Tsuei is submitted. Dr. Tsuei's affidavit is in agreement with the earlier submitted affidavit of Drs. Donger and Mitzi and states that applicants initi-

ated high temperature superconductor field and the teaching in applicants' specification enables a person of skill in the art to fabricate and use the invention as claimed by applicants.

Claims 24-26, 86-90 and 96-108 have been rejected under 35 USC §102(a) as being anticipated by the Asahi Shinbum article and under 35 USC §103 in view of the Asahi Shinbum article. In addition to applicants' remarks in regard to this rejection in applicant's prior response please consider the following.

The date of the Asahi Shinbum article is November 28, 1986. As stated in applicants' specification at page 6, lines 7-10:

The basis for our invention has been described by us in the following previously published article: J.G. Bednorz and K.A. Muller, Zeitschrift fur Physik B - Condensed Matter, 64, pp. 189-193 Sept. (1986)

The Examiner is using Asahi Shinbum as a reference under 35 USC §102(a). Applicants respectfully disagree since to do so does not permit applicants the one year period provided under 35 USC §102(b) to file a US application after their own publication which permitted applicants to file the present application up to September 1987. The date of the Asahi Shinbum article is after the date of applicants' publication.

Applicants believe this is not a correct application of 35 USC §102. The Court of Custom and Patent Appeal in *In re Katz* 215 USPQ 14, 17 (a copy of which is attached) states that

It may not be readily apparent from the statutory language that a printed publication cannot stand as a reference under §102(a) unless it is describing the work of another. A literal reading might appear to make a prior patent or printed publication "prior art" even though the disclosure is that of the applicant's own work. However, such an interpretation of this section of the statute would negate the one year period afforded under §102(b)¹ during which an inventor is allowed

to perfect, develop and apply for a patent on his invention and publish descriptions of it if he wishes.

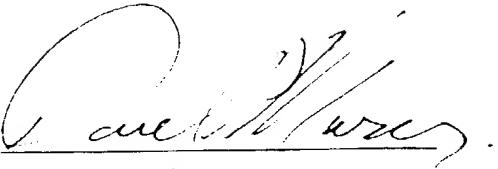
Thus, one's own work is not prior art under §102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under §102(a). Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter obvious therefrom only when the disclosure occurred more than one year prior to the date of the application, that is, when the disclosure creates a one-year time bar, frequently termed a "statutory bar," to the application under §102(b). As stated by this court in *In re Facius*, 56 CCPA 1348, 1358, 408 F.2d 1396, 1406, 161 USPQ 294, 302 (1969), "But certainly *one's own invention*, whatever the form of disclosure to the public, may not be prior art against oneself, *absent a statutory bar*." [Emphasis in original]².

The Asahi Shinbum article states in the first paragraph:

A new ceramic with a very high T_c of 30K of the superconducting transition has been found. The possibility of high T_c - superconductivity has been reported by scientists in Switzerland this spring. The group of Prof. Shoji TANAKA, Dept. Appl. Phy. Faculty of Engineering at the University of Tokyo confirmed in November, that this is true.

The "scientists in Switzerland" are the inventors of the above-identified application. The Asahi Shinbum article only reports the work of applicants and that it was reproduced by Prof. Tanaka. This article is a disclosure of applicants' "own invention" and cannot be used as a reference. Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 24-26, 86-90 and 96-108 under 35 USC §102(a) as anticipated by Asahi Shinbum and under 35 USC §103 as obvious over Asahi Shinbum.

By:


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